

# Notice of Allowability

Application No.

09/954,646

Examiner

Michael Rozanski

Applicant(s)

FOERSTER ET AL.

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE filed 11/1/07 and arguments filed 10/30/07.
2. ☒ The allowed claim(s) is/are 50,51,55-60,62 and 65-67.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with John Welsh on 1/18/08. Applicant agreed to amend the claims to clarify that the deploying results in the marker element being positioned in the patient's tissue such that the applier can be withdrawn while leaving the marker in the tissue.

The application has been amended as follows:

**1) The priority claim sentence of the specification has been amended as follows:**

**This [AppIn] Application is a [con't] continuation of [SN.] Application Serial No. 09/776,125, filed Feb. 2, 2001, now U.S. Patent No. 7,044,957, which is a [con't] continuation of [SN.] Application Serial No. 08/858,389, filed May 19, 1997, [PN.] now U.S. Patent No. 6,228,055, which is a [con't] continuation of [SN.] Application Serial No. 08/308,097, filed Sept. 16, 1994, [ABN] now abandoned.**

**2) Claim 50 has been amended as follows:**

**50. A method of marking a biopsy site in a patient's body, the method comprising the steps of:**

**a) providing a marker element applier having a proximal end, a distal end, and a side exit port positioned between the proximal end and the distal end;**

- b) providing a marker element comprising a radiopaque material and adapted to be deployed from the marker element applier;*
- c) positioning the side exit port of the marker element applier adjacent a site from which a biopsy sample had been taken; [and]*
- d) applying a force to a marker element disposed within the marker element applier to radially deploy the marker element through the side exit port of the marker element applier, such that no part of the marker element extends outside the body[.]; and*
- e) withdrawing the marker element applier from the body while leaving the marker element therein.*

*3) In claim 56, line 3, replace "comprising" with --consisting of--*

*4) Claim 60 has been amended as follows:*

*60. A method for use in a breast biopsy procedure, the method comprising the steps of:*

- a) positioning a marker element applier having a side exit port within breast tissue in a body with the aid of an imaging system selected from the group consisting of x-ray, ultrasound, and magnetic resonance imaging systems; [and]*
- b) radially deploying a marker element through the side exit port of the marker element applier, such that no part of the marker element extends outside the body[.]; and*

**c) withdrawing the marker element applier from the body while leaving the marker element therein.**

**5) In claim 67, line 3, replace "comprising" with --consisting of--**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR  
MR

 ERIC F. WINAKUR  
PRIMARY EXAMINER